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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,496	10/14/2003	William G. Tatton	IFM-001CPCN5	3544
959	7590	11/15/2006	EXAMINER	
LAHIVE & COCKFIELD, LLP ONE POST OFFICE SQUARE BOSTON, MA 02109-2127			FAY, ZOHREH A	
			ART UNIT	PAPER NUMBER
			1618	
DATE MAILED: 11/15/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/686,496	Applicant(s) TATTON ET AL.	
	Examiner Zohreh A. Fay	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 1 and 3-17 are presented for examination.

The remarks filed on August 21, 2006 have been received and entered.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 3-17 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well established utility.

The phrase "rescuing damaged nerve cells" is considered to be non-specific.

Claims 1 and 3-17 are also rejected under 35 U.S.C. 112, first paragraph.

Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 3-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The factors to be considered whether a disclosure meets the enablement requirements of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir.1988). Among these factors are:

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1) The nature of the invention:

The claims are drawn to a method of rescuing damaged nerve cells in a patient using a deprenyl compound.

2) The state of the prior art:

The prior art does not recognize that all neurodegenerative neuromuscular disorders are the same in nature and can be treated in the same manner. According to Lance, Current Medical Diagnosis and Treatment, 43rd edition, pages 50-52 and 971-974 and pages the treatment of Parkinson and Alzheimer is done differently.

3) The relative skill of those in the art:

The relative skill of those in the art is high.

4) The predictability or unpredictability of the art:

The unpredictability of pharmaceutical and chemical art is high.

5) The breath of the claims:

The claims are very broad and encompass a composition for treating all disorders associated with damaged nerve cells.

6) The amount of direction or guidance provided:

Applicant's specification provides no guidance as how the treatment of disorders associated with damaged nerve cells is accomplished. Applicant's specification does not set forth any examples to demonstrate that the claimed compounds are capable of treating any disorders associated with damaged nerve cells.

7) The presence or absence of working examples;

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The examples in applicant's specification are drawn to the protective effect of deprenyl on rescuing nerve cells in vitro. However, no correlation has been established between such effect and treating neurodegenerative, neuromuscular disorders.

8) The quantity of experimentation necessary;

Since activity of compounds for pharmaceutical use must be determined from case to case by painstaking experimental study, one of ordinary skill in the art would be burdened with undue experimentation to determine all neurodegenerative and neuromuscular disorders, which can be, treated with the claimed deprenyl compounds.

Claims 1 and 3-17 are rejected under non-statutory obviousness double patenting as being unpatentable over claims 1-21 of the U.S. Patent 5,884,003.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap. The claims of the instant application are drawn to certain deprenyl compounds for rescuing damaged nerve cells. The claims of the U.S. Patent are drawn to certain deprenyl compounds for rescuing damaged nerve cells. The claims of the U.S. Patent are within the scope of the claims of instant application.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, and 3-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Tatton et al. (U.S. patent 5,844,003). Tatton et al. teach the use of the claimed deprenyl

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compounds for rescuing damaged nerve cell in a patient. See column 8, lines 15-67, column 9, lines 1-67 and claims 1-21. The above reference makes clear that the claimed method of use is old and well known.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zohreh A. Fay whose telephone number is (571) 272-0573. The examiner can normally be reached on Monday to Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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ZACHARY FAY
PRIMARY EXAMINER
GROUP 1200

Zachary Fay